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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	08/997,706	EJIRI, SEISHI
	<b>Examiner</b>	<b>Art Unit</b>
	Joseph R. Pokrzywa	2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 June 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4,7-11,17-19 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 17 is/are allowed.
- 6) Claim(s) 1-4,7-11,18,19 and 21-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 6/29/04, and has been entered and made of record. Currently, **claims 1-4, 7-11, 17-19, and 21-28** are pending.

### *Response to Arguments*

2. Applicant's arguments, seen on pages 19-23, filed 6/29/04, with respect to the rejection of the presently amended independent claims 1, 7, 18, 19, 21-24, 27, and 28, as cited in the Office action dated 3/29/04 under 35 U.S.C. 103(a) as being unpatentable over Ikeda *et al.* (U.S. Patent Number 5,720,014) in view of Hashimoto (U.S. Patent Number 5,838,459), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration of the current amended claims, a new ground(s) of rejection is made in view of the previously cited reference of Kikuchi *et al.* (U.S. Patent Number 5,552,901), with a full discussion below.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-4, 7-11, 18, 19, and 21-28** are rejected under 35 U.S.C. 102(b) as being anticipated by Kikuchi *et al.* (U.S. Patent Number 5,552,901, cited in the Office action dated 4/3/03).

Regarding ***claim 1***, Kikuchi discloses a data communication system (remote FAX 9, see Figs. 1, 3, and 4), which comprises a connector, adapted to connect a network that is connectable to a plurality of data processing terminals to the data communication system (LAN 4, see Fig. 1, clients 3, and fax server 1), an operation input unit, adapted to receive a manual instruction from an operator (operation control unit 22, column 5, lines 28-65), a data transmitter, adapted to transmit a document based on the instruction input by the operation input unit (column 5, lines 28-65), with the document being transmitted to an external data communication terminal (fax 6) via a line (public switched network 5) that does not include the connector (see Fig. 1, column 10, lines 57-67, and column 12, lines 19-36), a transfer unit (LAN control unit 21), adapted to transfer transmission result information representing a result of the document transmission performed by the data transmitter (column 12, lines 6-67, and column 20, lines 4-24, whereby communication history information is periodically collected) and the document (column 8, line 58-column 9, line 2) transmitted by the data transmitter to one of the plurality of data processing terminals via the connector (fax server 1, whereby the document is transferred via LAN 4 to the

fax server 1, which is then transmitted via the network 5, therein being “the document transmitted by the data transmitter”), and a discrimination unit, adapted to discriminate user information input by the operation input unit in a case where the data transmitter transmits the document (column 17, lines 55-67), wherein the transfer unit transfers the transmission result information and the document based on the user information discriminated by the discrimination unit (column 8, line 58-column 9, line 2, column 17, lines 55-column 18, line 19, and column 19, lines 7-31).

Regarding *claim 2*, Kikuchi discloses the data communication system discussed in claim 1 above, and further teaches that the data transmitter transmits the document based on a second instruction from the data processing terminal connected to the data communication system via the connector (column 8, line 9-column 9, line 9).

Regarding *claim 3*, Kikuchi discloses the data communication system discussed in claim 1 above, and further teaches of the transmission result information transferred by the transfer unit includes a transmission destination (see Figs. 5-7).

Regarding *claim 4*, Kikuchi discloses the data communication system discussed in claim 1 above, and further teaches of the transfer unit notifies the data processing terminal of the transmission result information in accordance with a change in information to be notified (column 12, lines 6-67, and column 20, lines 4-24).

Regarding *claim 7*, Kikuchi discloses a data communication system (remote FAX 9, see Figs. 1, 3, and 4) comprising a connector, adapted to connect a network that is connectable to a plurality of data processing terminals to the data communication system (LAN 4, see Fig. 1, clients 3, and fax server 1), an operation input unit, adapted to receive a manual instruction from

an operator (operation control unit 22, column 5, lines 28-65), a designation unit, adapted to designate an ID for specifying a data processing terminal on the network connected by the connector (column 8, lines 37-45), a data transmitter, adapted to transmit a document based on the designation input by the operation input unit (column 5, lines 28-65), with the document being transmitted to an external data communication terminal (fax 6) via a line (public switched network 5) that does not include the connector (see Fig. 1, column 10, lines 57-67, and column 12, lines 19-36), a transfer unit (LAN control unit 21), adapted to transfer transmission result information representing a result of the document transmission performed by the data transmitter based on the designation input by the operation unit (column 12, lines 6-67, and column 20, lines 4-24, whereby communication history information is periodically collected) and the document (column 8, line 58-column 9, line 2) transmitted by the data transmitter to one of the plurality of data processing terminals connected by the connector (fax server 1, whereby the document is transferred via LAN 4 to the fax server 1, which is then transmitted via the network 5, therein being “the document transmitted by the data transmitter”), and a determination unit, adapted to determine whether or not the ID is designated by the designation unit (column 8, lines 37-45, and column 17, line 55-column 18, line 59), and a transfer control unit, adapted to control the transfer unit in accordance with a determination result by the determination unit (column 8, line 58-column 9, line 2, column 17, lines 55-column 18, line 19, and column 19, lines 7-31).

Regarding **claim 8**, Kikuchi discloses the data communication system discussed in claim 7 above, and further teaches that the transfer unit does not transfer the information in absence of an ID designated by the designation unit (column 19, line 55-column 20, line 11, whereby when no request is received, thereby having ID input, information is not transferred).

Regarding *claim 9*, Kikuchi discloses the data communication system discussed in claim 7 above, and further teaches that the ID designated by the designation unit is information representing a user on a network (column 8, lines 37-45).

Regarding *claim 10*, Kikuchi discloses the data communication system discussed in claim 7 above, and further teaches that the data transmitter transmits the document, based on the designated ID, from the data processing terminal connected to the data communication system via the connector (column 10, lines 57-67, and column 12, lines 19-36).

Regarding *claim 11*, Kikuchi discloses the data communication system discussed in claim 7 above, and further teaches that the information transferred by the transfer unit includes a transmission destination (see Figs. 5-7).

Regarding *claim 18*, Kikuchi discloses a computer-readable medium storing a program for implementing a method for controlling a data communication system (remote FAX 9, see Figs. 1, 3, and 4, and column 13, lines 28-35, wherein the system inherently stores a program on a computer-readable medium) connected to a network that is connectable to a plurality of data processing terminals via a connector (LAN 4, see Fig. 1, clients 3, and fax server 1), with the program comprising program code for an input step of receiving an instruction manually inputted by an operator using an operation input unit (operation control unit 22, column 5, lines 28-65), program code for a transmission step of transmitting a document based on the instruction manually inputted in the input step (column 5, lines 28-65), with the document being transmitted to an external data communication terminal (fax 6) via a line (public switched network 5) that does not include the connector (see Fig. 1, column 10, lines 57-67, and column 12, lines 19-36), program code for a transfer step of transferring transmission result information representing a

result of the document transmission performed in the transmission step (column 12, lines 6-67, and column 20, lines 4-24, whereby communication history information is periodically collected) and the document (column 8, line 58-column 9, line 2) transmitted in the transmission step to one of the plurality of data processing terminals via the connector (fax server 1, whereby the document is transferred via LAN 4 to the fax server 1, which is then transmitted via the network 5, therein being “the document transmitted by the data transmitter”), and program code for a discrimination step of discriminating user information input in the input step in a case where the transmission step transmits the document (column 17, lines 55-67), wherein the transfer step transfers the transmission result information and the document based on the user information discriminated in the discrimination step (column 8, line 58-column 9, line 2, column 17, lines 55-column 18, line 19, and column 19, lines 7-31).

Regarding **claim 19**, Kikuchi discloses a computer-readable medium storing a program for implementing a method for controlling a data communication system (remote FAX 9, see Figs. 1, 3, and 4, and column 13, lines 28-35, wherein the system inherently stores a program on a computer-readable medium) connected to a network that is connectable to a plurality of data processing terminals via a connector (LAN 4, see Fig. 1, clients 3, and fax server 1), with the program comprising program code for an input step of receiving an instruction manually inputted by an operator using an operation input unit that is part of the data communication system (operation control unit 22, column 5, lines 28-65), program code for a designation step of designating an ID for specifying a data processing terminal on the network connected by the connector, from the designation manually inputted (column 8, lines 37-45), program code for a transmission step of transmitting a document based on the instruction manually inputted in the

input step (column 5, lines 28-65), with the document being transmitted to an external data communication terminal (fax 6) via a line (public switched network 5) that does not include the connector (see Fig. 1, column 10, lines 57-67, and column 12, lines 19-36), program code for a transfer step of transferring information representing a document transmission performed in the transmission step (column 12, lines 6-67, and column 20, lines 4-24, whereby communication history information is periodically collected) based on the designation inputted in the input step and the document (column 8, line 58-column 9, line 2) transmitted in the transmission step to one of the plurality of data processing terminals connected by the connector (fax server 1, whereby the document is transferred via LAN 4 to the fax server 1, which is then transmitted via the network 5, therein being “the document transmitted by the data transmitter”), and program code for a determination step of determining whether the ID is designated in the designation step (column 8, lines 37-45, and column 17, line 55-column 18, line 59), and program code for a transfer control step of controlling the transfer step in accordance with a determination result of the determination step (column 8, line 58-column 9, line 2, column 17, lines 55-column 18, line 19, and column 19, lines 7-31).

Regarding *claim 21*, Kikuchi discloses a data communication system (remote FAX 9, see Figs. 1, 3, and 4) which communicates with an external device (fax 6) via a transmission path (public switched network 5), and that communicates with a data processing terminal (see abstract), the system comprising a signal path through which the data communication system communicates with the data processing terminal (LAN 4, see Fig. 1, clients 3, and fax server 1), with the signal path being a path different from the transmission path (see Fig. 1), an input section through which an operator manually inputs an instruction to the data communication

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system (operation control unit 22, column 5, lines 28-65), a transmitter that, based upon the manually inputted instruction, transmits a document through the transmission path to the external device (see Fig. 1, column 10, lines 57-67, and column 12, lines 19-36), a transfer section (LAN control unit 21) that transfers transmission result information representing a result of the document transmission performed by the transmitter to the data processing terminal by the signal path (column 12, lines 6-67, and column 20, lines 4-24, whereby communication history information is periodically collected), a discriminator that discriminates user information input in the input section in a case where the transmitter transmits the document (column 17, lines 55-67), wherein the transfer section transfers the transmission result information and the document (column 8, line 58-column 9, line 2, whereby the document is transferred via LAN 4 to the fax server 1, which is then transmitted via the network 5, therein being “the document transmitted by the data transmitter”) based on the user information discriminated by the discriminator (column 8, line 58-column 9, line 2, column 17, lines 55-column 18, line 19, and column 19, lines 7-31).

Regarding *claim 22*, Kikuchi discloses a method of controlling a data communication system (remote FAX 9, see Figs. 1, 3, and 4) that communicates with an external device (fax 6), and with a data processing terminal (fax server 1, see abstract), the method comprising manually inputting an instruction to the data communication system (operation control unit 22, column 5, lines 28-65), transmitting a document to the external device via a transmission path (public switched network 5), based upon the manually inputted instruction, the transmitting step producing transmission result information (see Fig. 1, column 10, lines 57-67, and column 12, lines 19-36), transferring the transmission result information representing a result of the document transmission performed in the transmitting step (column 12, lines 6-67, and column

20, lines 4-24, whereby communication history information is periodically collected) and the document (column 8, line 58-column 9, line 2) transmitted in the transmitting step to the data processing terminal (fax server 1, whereby the document is transferred via LAN 4 to the fax server 1, which is then transmitted via the network 5, therein being “the document transmitted by the data transmitter”), and discriminating user information input in the input step in a case where the transmitting step transmits the document (column 17, lines 55-67), wherein the transferring step transfers the transmission result information and the document based on the user information discriminated in the discriminating step (column 8, line 58-column 9, line 2, column 17, lines 55-column 18, line 19, and column 19, lines 7-31).

Regarding **claim 23**, Kikuchi discloses a computer-readable storage medium storing a program for implementing a method for controlling a data communication system (remote FAX 9, see Figs. 1, 3, and 4, and column 13, lines 28-35, wherein the system inherently stores a program on a computer-readable medium) that communicates with an external device (fax 6), and with a data processing terminal (fax server 1, see abstract), the program comprising code for an input step of inputting a manual instruction to the data communication system (operation control unit 22, column 5, lines 28-65), code for a transmission step of transmitting a document to the external device via a transmission path (public switched network 5), based upon the inputted manual instruction, the transmission step producing transmission result information (see Fig. 1, column 10, lines 57-67, and column 12, lines 19-36), code for a transfer step of transferring the transmission result information representing a result of the document transmission performed in the transmission step (column 12, lines 6-67, and column 20, lines 4-24, whereby communication history information is periodically collected) and the document

(column 8, line 58-column 9, line 2) transmitted in the transmission step to the data processing terminal (fax server 1, whereby the document is transferred via LAN 4 to the fax server 1, which is then transmitted via the network 5, therein being “the document transmitted by the data transmitter”), and code for a discrimination step of discriminating user information inputted in the input step in a case where the transmission step transmits the document (column 17, lines 55-67), wherein the transfer step transfers the transmission result information and the document based on the user information discriminated in the discrimination step (column 8, line 58-column 9, line 2, column 17, lines 55-column 18, line 19, and column 19, lines 7-31).

Regarding **claim 24**, Kikuchi discloses a data communication system (remote FAX 9, see Figs. 1, 3, and 4), which comprises a connector, adapted to connect a network that is connectable to a plurality of data processing terminals to the data communication system (LAN 4, see Fig. 1, clients 3, and fax server 1), an operation input unit, adapted to receive an instruction manually inputted by an operator (operation control unit 22, column 5, lines 28-65), an input unit, adapted to input a document to be transmitted to a destination (scanner 90, column 5, lines 53-65), a data transmitter, adapted to transmit a document input by the input unit based on the instruction input by the operation input unit (column 5, lines 28-65), with the document being transmitted to the destination (fax 6) via a line (public switched network 5) that does not include the connector (see Fig. 1, column 10, lines 57-67, and column 12, lines 19-36), a transfer unit (LAN control unit 21), adapted to transfer transmission result information representing a result of the document transmission performed by the data transmitter (column 12, lines 6-67, and column 20, lines 4-24, whereby communication history information is periodically collected) and the document (column 8, line 58-column 9, line 2) transmitted by the data transmitter to the data processing

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terminal (fax server 1, whereby the document is transferred via LAN 4 to the fax server 1, which is then transmitted via the network 5, therein being “the document transmitted by the data transmitter”), and a discrimination unit, adapted to discriminate user information inputted by the operation input unit in a case where the data transmitter transmits the document (column 17, lines 55-67), wherein the transfer unit transfers the transmission result information and the document based on the user information discriminated by the discrimination unit (column 8, line 58-column 9, line 2, column 17, lines 55-column 18, line 19, and column 19, lines 7-31).

Regarding *claim 25*, Kikuchi discloses the data communication system discussed in claim 24 above, and further teaches that the connector (LAN 4) connects a network that is connectable to a plurality of data processing terminals to the data communication system (see Fig. 1, clients 3, and fax server 1).

Regarding *claim 26*, Kikuchi discloses the data communication system discussed in claim 24 above, and further teaches of a reader which reads an image on a document and generates an image document (scanner 90), wherein the input unit inputs the image document from the reader and the data transmitter transmits the image document inputted by the input unit (column 5, lines 53-65).

Regarding *claim 27*, Kikuchi discloses a method of controlling a data communication system (remote FAX 9, see Figs. 1, 3, and 4), with the method comprising a reception step of receiving an instruction manually inputted by an operator (operation control unit 22, column 5, lines 28-65), an input step of inputting a document to be transmitted to a destination (scanner 90, column 5, lines 53-65), a transmission step of transmitting the document based on the instruction received in the reception step (column 5, lines 28-65) to the destination (fax 6) via a line (public

switched network 5) that does not include a connector (LAN 4) adapted to connect a data processing terminal to the data communication system (see Fig. 1, column 10, lines 57-67, and column 12, lines 19-36), a transfer step of transferring transmission result information representing a result of the document transfer in the transmission step (column 12, lines 6-67, and column 20, lines 4-24, whereby communication history information is periodically collected) and the document (column 8, line 58-column 9, line 2) transmitted in the transmission step to the data processing terminal via the connector (fax server 1, whereby the document is transferred via LAN 4 to the fax server 1, which is then transmitted via the network 5, therein being “the document transmitted by the data transmitter”), and a discrimination step of discriminating user information received in the reception step in a case where the transmission step transmits the document (column 17, lines 55-67), wherein the transfer step transfers the transmission result information and the document based on the user information discriminated in the discrimination step (column 8, line 58-column 9, line 2, column 17, lines 55-column 18, line 19, and column 19, lines 7-31).

Regarding *claim 28*, Kikuchi discloses a computer-readable storage medium storing a program for implementing a method of controlling a data communication system (remote FAX 9, see Figs. 1, 3, and 4, and column 13, lines 28-35, wherein the system inherently stores a program on a computer-readable medium), with the program comprising program code for a reception step of receiving an instruction manually inputted by an operator (operation control unit 22, column 5, lines 28-65), program code for an input step of inputting a document to be transmitted to a destination (scanner 90, column 5, lines 53-65), program code for a transmission step of transmitting the document based on the instruction received in the reception step (column 5, lines

28-65) to the destination (fax 6) via a line (public switched network 5) that does not include a connector (LAN 4) adapted to connect a data processing terminal to the data communication system (see Fig. 1, column 10, lines 57-67, and column 12, lines 19-36), program code for a transfer step of transferring transmission result information representing a result of the document transfer in the transmission step (column 12, lines 6-67, and column 20, lines 4-24, whereby communication history information is periodically collected) and the document (column 8, line 58-column 9, line 2) transmitted in the transmission step to the data processing terminal via the connector (fax server 1, whereby the document is transferred via LAN 4 to the fax server 1, which is then transmitted via the network 5, therein being "the document transmitted by the data transmitter"), and program code for a discrimination step of discriminating user information received in the reception step in a case where the transmission step transmits the document (column 17, lines 55-67), wherein the transfer step transfers the transmission result information and the document based on the user information discriminated in the discrimination step (column 8, line 58-column 9, line 2, column 17, lines 55-column 18, line 19, and column 19, lines 7-31).

***Allowable Subject Matter***

5. **Claim 17** is allowed.
6. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claim 17**, in the examiner's opinion, it would not have been obvious to have the system, as claimed, include the limitations requiring at the data communication system, inputting a designation manually entered by an operator using an operation input unit, and designating an ID based on the manual designation inputted using the operation input unit, as

well as at the data processing terminal, the limitation of independently storing the communication result information related to the document communication.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa  
Examiner  
Art Unit 2622

jrp

A handwritten signature in black ink, appearing to read "Joseph R. Pokrzywa".